



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,609	03/09/2004	Eiji Kato	FY.51042US1A	1785
20995 7590 03/19/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
ILAN, RUTH				
ART UNIT		PAPER NUMBER		
3616				
NOTIFICATION DATE		DELIVERY MODE		
03/19/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

# Office Action Summary

## Application No.

10/796,609

## Applicant(s)

KATO ET AL.

## Examiner

Ruth Ilan

## Art Unit

3616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1.5-26 and 29-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37 is/are allowed.
- 6) ☒ Claim(s) 1.5-26 and 29-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/7/2009 has been entered.
2. The indicated allowability of claim 28 is withdrawn in view of the newly discovered reference(s) to Cross and Babbitt and King. Rejections based on the newly cited reference(s) follow.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 10 and those that depend from claim 10 include third and fourth groups, which were not previously discussed in the specification. Additionally, the first and second groups discussed in the amended claims include elements that were not previously described in the specification as belonging to the first and second groups. As an example, the specification describes the first and second group as forming the main frame. However, member 46, is not described as part of the first or second group in the specification, and it is the only member disclosed that properly meets the limitations of claim 9.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-24, 29-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 9, line 5, "the engine" lacks antecedent basis. Regarding claim 19, "the front member" and "the rear member" both lack antecedent basis.

***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claim 9-11, 13, 15-17, 21, and 32-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Enokimoto et al. (US 4,817,985.) Regarding claim 9, as seen in Figure 3, Enokimoto et al. teaches an off-road vehicle including a plurality of wheels supporting a frame and a prime mover (11). The frame members include first and second groups, First group includes 2, second group includes 3. Frame member 2 is above 3 and as seen in Figure 3 and 4, there is a portion of 3 behind 11 that is closer together than 2. Also as seen in Figure 3, at least a portion of the exhaust system is between the second group. Regarding claim 21, the frame members are tubular. Regarding claim 10, if pipes 3 are considered the third group, and all the other pipes are considered the fourth group, then they are offset (because as seen in Figure 5, 2 does not extend to the very front of the vehicle) Additionally the rear section of 3 is further

from the centerline than the front of 2 (as seen in Figure 6.) Or regarding claims 10, 11, 16 and 17, if 3 is considered the 4<sup>th</sup> group and all the other pipes the third group, the rear of pipes 3 is further from the center line than the front of 2. Claim 35 is met because pipes 3 can be the 4<sup>th</sup> group. Under this interpretation, claim 11 is met, since the front wheels are coupled with some of the pipes that are not 3. Regarding claim 13, pipes 4 can be included in the fourth group, and then this limitation is met. Regarding claim 15, the vehicle is symmetrical.

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. Claims 1, 5-8, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosuge (US 4,798,400) in view of Cross (US 6,209,941) or Babitt et al. (US 6,250,529) or King (US 6,425,510.) Kosuge teaches an off-road vehicle having a frame (see Figure 3) a plurality of wheels having at least one front wheel (10) and a prime mover (18) powering at least one of the wheels, the prime mover being mounted on the frame (see Figure 3) and the frame having a plurality of frame portions including at least first, second and third frame portions that extend adjacent to the primer mover, the first and second frame (7, 7a, and 2) being disposed generally to the lateral sides of the prime mover with the third frame portion (7b) extending generally between the first and second frame portions. Regarding the detachably affixed frame portion extending adjacent to an upper portion of the prime mover, it is the Examiner's position that the member 17 can, broadly and reasonably be considered a frame portion, and it extends

in the claimed location. Figure 3 shows that this frame portion is connected to 7 by three attachments, which schematically appear to be screw or rivet connections, but does not specifically disclose that they are detachable. Detachable connections, such as bolts, screws, rivets are well known in the attachment art. Thus it would have been obvious to a person of ordinary skill in the art to select from amongst any of the well known attachment types, as person of ordinary skill has good reasons to pursue the known options within his or her technical grasp. Kosuge et al. fails to teach a load carrier that is a separate element from member 17, which is the utility rack of the Kosuge vehicle. Cross, Babbitt et al. and King all teach that it is well known in the atv art to provide a detachable load carrier coupled to the rack of an atv in order to provide protective carrying of various articles. It would have been obvious to one having ordinary skill in the art to couple a load carrier to the frame portion 17, which is a rack, since each of these references teach that they are designed to be attached to racks, in order to provide protective carrying.

10. . Claims 9, 21-23, 32-34 are rejected under 35 U.S.C. 103(a) as being obvious over Rasidescu et al. (US 5,975,624) in view of Sato (US 6,250,415.) Rasidescu et al. teaches an off-road vehicle including a plurality of wheel and a prime mover (88) see Figure 17. The frame comprises a plurality of frame members and the frame members are in first and second groups; 22 are in the first group and 62 are in the second, they both have rear portions that are positioned behind the engine (see Figure 10.) The first group is above the second group and is wider than the second group (see Figure 4.) Rasidescu et al. is silent regarding the placement of the exhaust system. It is well

understood in the vehicle art that internal combustion vehicles include exhaust systems that are used to exhaust combustion gases away from the occupants of the vehicle. Sato teaches one such exhaust system, as claimed which is located protectively under and between the rear rails of the frame (see Sato col. 6, lines 30-37.) Based on the teaching of Sato, it would have been obvious to one having ordinary skill in the art at the time of the invention to include an exhaust system as claimed on the vehicle of Rasidescu et al. in order to provide a protected way to direct combustion products away from the vehicle. Regarding claims 21-23, the frame members are tubular and rectangular in section. Further regarding claim 23, Rasidescu et al. does not specifically describe the dimensions of the rectangular members, and as such does not specifically indicate that the vertical dimension is longer than the width dimension. However, members are structured as reinforcing members for the horizontal frame plates, and as such it would be reasonable to assume that they are taller than they are wide. Additionally, it has been held that a change in shape is well within the level of ordinary skill in the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

***Allowable Subject Matter***

11. Claim 37 is allowed.
12. Claims 12, 14, 18-20, 29-31 and 36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth Ilan whose telephone number is 571-272-6673. The examiner can normally be reached on Monday-Friday, 8:30-5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Nguyen can be reached on 571-272-6952. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ruth Ilan  
Primary Examiner  
Art Unit 3616

/Ruth Ilan/  
Primary Examiner, Art Unit 3616